



Docket No.: 284224US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 10/566,092
Applicants: Dimitri LEROY, et al.
Filing Date: January 27, 2006
For: MATERIAL HAVING SOUND-DAMPING AND
ADHESIVE PROPERTIES
Group Art Unit: 1733
Examiner:

SIR:

Attached hereto for filing are the following papers:

Letter

English Translation of International Preliminary Examination Report

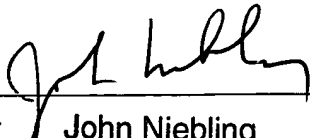
Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Frederick D. Vastine, Ph.D.

Registration No. 27,013


John Niebling
Registration No. 57,981

Customer Number

22850

(703) 413-3000 (phone)
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DOCKET NO: 284224US01A

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
DIMITRI LEROY :
SERIAL NO: 10/566,092 :
FILED: JANUARY 27, 2006 : GROUP ART UNIT: 1733
FOR: MATERIAL HAVING SOUND- :
DAMPING AND ADHESIVE
PROPERTIES

LETTER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants wish to make of record the attached English translation of the International Preliminary Report on Patentability. Copies of the references listed therein were filed on January 27, 2006.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Frederick D. Vastine, Ph.D. **John Niebling**
Registration No. 27,013 **Registration No. 57,981**

Customer Number
22850

Tel: (703) 413-3000
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TRANSLATION

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference MA7 03068PCT	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/IB2004/003543	International filing date (day/month/year) 21. 07. 2004	Priority date (day/month/year) 30. 07. 2003
International Patent Classification (IPC) or national classification and IPC B60J10/00, C08G18/12, C09K3/10		
Applicant SAINT-GOBAIN PERFORMANCE PLASTICS		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 7 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☐ (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:

☐ sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

<input checked="" type="checkbox"/>	Box No. I	Basis of the report
<input type="checkbox"/>	Box No. II	Priority
<input checked="" type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
<input type="checkbox"/>	Box No. IV	Lack of unity of invention
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
<input type="checkbox"/>	Box No. VI	Certain documents cited
<input type="checkbox"/>	Box No. VII	Certain defects in the international application
<input checked="" type="checkbox"/>	Box No. VIII	Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This report is based on translations from the original language into the following language _____ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
 - ☐ publication of the international application (Rule 12.4)
 - ☐ international preliminary examination (Rule 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

- ☐ the international application as originally filed/furnished

- ☒ the description:

pages 1-20 as originally filed/furnished

pages* _____ received by this Authority on _____

pages* _____ received by this Authority on _____

- ☒ the claims:

nos. 1-19 as originally filed/furnished

nos.* _____ as amended (together with any statement) under Article 19

nos.* _____ received by this Authority on _____

nos.* _____ received by this Authority on _____

- ☐ the drawings:

sheets _____ as originally filed/furnished

sheets* _____ received by this Authority on _____

sheets* _____ received by this Authority on _____

- ☐ a sequence listing and/or any related table(s) -- see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

☐ the description, pages _____

☐ the claims, nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (specify): _____

☐ any table(s) related to sequence listing (specify): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

☐ the description, pages _____

☐ the claims, nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (specify): _____

☐ any table(s) related to sequence listing (specify): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos. 1-4

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. 1-4

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C' of the Administrative Instructions in that:

the written form

☐ has not been furnished

☐ does not comply with the standard

the computer readable form

☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C'-bis of the Administrative Instructions.

☒ See Supplemental Box for further details.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	5-19	YES
	Claims		NO
Inventive step (IS)	Claims	5-19	YES
	Claims		NO
Industrial applicability (IA)	Claims	5-19	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
Reference is made to the following documents:			
D1: DATABASE WPI Week 199236 Derwent Publications Ltd., London, GB; AN 1992-295481 XP002287569 "Resin compositions for damping sheet steel" & JP 04 202316 A (NIPPON SYNTHETIC) 23 July 1992 (1992-07-23)			
D2: PATENT ABSTRACTS OF JAPAN vol. 0154, no. 25 (C-0879), 29 October 1991 (1991-10-29) & JP 03 177412 A (NISSHIN STEEL CO LTD; others: 01), 1 August 1991 (1991-08-01)			
1. Novelty			
1.1 No prior art document describes a damping material having the properties of claim 1 and comprising the components (a) and (b) of claim 5 of the application. The subject matter of claim 5 is therefore novel (PCT Article 33(2)).			
2. Inventive step			
2.1 D2 is considered to be the closest prior art, since it solves the same technical problem, namely that of finding a damping material that can function			

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability:
citations and explanations supporting such statement

simultaneously as a bonding material.

The difference between the subject matter of claim 5 and D2 lies in the use, in the application, of a component (b) and the property of the material of claim 5 of having a $\tan \delta$ loss factor no less than 0.25.

For the present invention, the problem to be solved is that of providing alternative damping materials. In so far as the prior art does not describe the use of a component (b) and a damping material comprising components (a) and (b) having a $\tan \delta$ loss factor no less than 0.25, the subject matter of claim 5 of the present application is considered to involve an inventive step (PCT Article 33(3)).

3. Dependent claims

3.1 Claims 6 to 19 are dependent on claim 5 and thus also comply, as such, with the PCT requirements of novelty and inventive step.

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of: Box III

1. **Clarity and support**

1.1 No search has been carried out on certain claims, because they relate to parts of the application that fail to comply with the prescribed requirements to a sufficient extent for a meaningful search to be carried out:

Claims on which full searches have been carried out: 5 to 9;

Claims on which no searches have been carried out: 1 to 4.

Reason for limiting the search:

The present claims 1 to 4 relate to a desirable feature or property, namely a tan delta loss factor no less than 0.25 and having two glass transition temperatures of which at least one is substantially close to the temperature of use. The claims cover all the materials having this feature or property, whereas the application only provides support, within the meaning of PCT Article 5, for a very limited number of such materials.

In the present case, the claims so lack support and the disclosure of the application is so limited as to render a meaningful search covering the entire claimed range impossible. Consequently, the search has been limited to the parts of the claims of which the subject matter appears to be clear, adequately supported and disclosed, i.e. the parts concerning the materials described in claims 5 to 19.

TRANSLATION

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference MA7 03068PCT	FOR FURTHER ACTION	See Form PCT/IPEA/416
International application No. PCT/IB2004/003543	International filing date (day/month/year) 21.07.2004	Priority date (day/month/year) 30.07.2003
International Patent Classification (IPC) or national classification and IPC B60J10/00, C08G18/12, C09K3/10		
Applicant SAINT-GOBAIN PERFORMANCE PLASTICS		

<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>7</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of _____ sheets, as follows:</p> <p><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>																									
<p>4. This report contains indications relating to the following items:</p> <table><tr><td><input checked="" type="checkbox"/></td><td>Box No. I</td><td>Basis of the report</td></tr><tr><td><input type="checkbox"/></td><td>Box No. II</td><td>Priority</td></tr><tr><td><input checked="" type="checkbox"/></td><td>Box No. III</td><td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td></tr><tr><td><input type="checkbox"/></td><td>Box No. IV</td><td>Lack of unity of invention</td></tr><tr><td><input checked="" type="checkbox"/></td><td>Box No. V</td><td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VI</td><td>Certain documents cited</td></tr><tr><td><input type="checkbox"/></td><td>Box No. VII</td><td>Certain defects in the international application</td></tr><tr><td><input checked="" type="checkbox"/></td><td>Box No. VIII</td><td>Certain observations on the international application</td></tr></table>		<input checked="" type="checkbox"/>	Box No. I	Basis of the report	<input type="checkbox"/>	Box No. II	Priority	<input checked="" type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input type="checkbox"/>	Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement	<input type="checkbox"/>	Box No. VI	Certain documents cited	<input type="checkbox"/>	Box No. VII	Certain defects in the international application	<input checked="" type="checkbox"/>	Box No. VIII	Certain observations on the international application
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Date of submission of the demand	Date of completion of this report																								
Name and mailing address of the IPEA/EP	Authorized officer																								
Facsimile No.	Telephone No.																								

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. 1 Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This report is based on translations from the original language into the following language _____ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
 - ☐ publication of the international application (Rule 12.4)
 - ☐ international preliminary examination (Rule 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

- ☐ the international application as originally filed/furnished

- ☒ the description:

pages 1-20 as originally filed/furnished

pages* _____ received by this Authority on _____

pages* _____ received by this Authority on _____

- ☒ the claims:

nos. 1-19 as originally filed/furnished

nos.* _____ as amended (together with any statement) under Article 19

nos.* _____ received by this Authority on _____

nos.* _____ received by this Authority on _____

- ☐ the drawings:

sheets _____ as originally filed/furnished

sheets* _____ received by this Authority on _____

sheets* _____ received by this Authority on _____

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

☐ the description, pages _____

☐ the claims, nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (specify): _____

☐ any table(s) related to sequence listing (specify): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

☐ the description, pages _____

☐ the claims, nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (specify): _____

☐ any table(s) related to sequence listing (specify): _____

* If item 4 applies, some or all of those sheets may be marked "superseded."

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos. 1-4

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. 1-4

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form

☐ has not been furnished

☐ does not comply with the standard

the computer readable form

☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-bis of the Administrative Instructions.

☒ See Supplemental Box for further details.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	5-19	YES
	Claims		NO
Inventive step (IS)	Claims	5-19	YES
	Claims		NO
Industrial applicability (IA)	Claims	5-19	YES
	Claims		NO
2. Citations and explanations (Rule 70.7)			
Reference is made to the following documents:			
D1: DATABASE WPI Week 199236 Derwent Publications Ltd., London, GB; AN 1992-295481 XP002287569 "Resin compositions for damping sheet steel" & JP 04 202316 A (NIPPON SYNTHETIC) 23 July 1992 (1992-07-23)			
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1. Novelty			
1.1 No prior art document describes a damping material having the properties of claim 1 and comprising the components (a) and (b) of claim 5 of the application. The subject matter of claim 5 is therefore novel (PCT Article 33(2)).			
2. Inventive step			
2.1 D2 is considered to be the closest prior art, since it solves the same technical problem, namely that of finding a damping material that can function			

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/IB2004/003543

Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
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simultaneously as a bonding material.

The difference between the subject matter of claim 5 and D2 lies in the use, in the application, of a component (b) and the property of the material of claim 5 of having a $\tan \delta$ loss factor no less than 0.25.

For the present invention, the problem to be solved is that of providing alternative damping materials. In so far as the prior art does not describe the use of a component (b) and a damping material comprising components (a) and (b) having a $\tan \delta$ loss factor no less than 0.25, the subject matter of claim 5 of the present application is considered to involve an inventive step (PCT Article 33(3)).

3. Dependent claims

3.1 Claims 6 to 19 are dependent on claim 5 and thus also comply, as such, with the PCT requirements of novelty and inventive step.

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of: Box III

1. **Clarity and support**

1.1 No search has been carried out on certain claims, because they relate to parts of the application that fail to comply with the prescribed requirements to a sufficient extent for a meaningful search to be carried out:

Claims on which full searches have been carried out: 5 to 9;

Claims on which no searches have been carried out: 1 to 4.

Reason for limiting the search:

The present claims 1 to 4 relate to a desirable feature or property, namely a tan delta loss factor no less than 0.25 and having two glass transition temperatures of which at least one is substantially close to the temperature of use. The claims cover all the materials having this feature or property, whereas the application only provides support, within the meaning of PCT Article 5, for a very limited number of such materials.

In the present case, the claims so lack support and the disclosure of the application is so limited as to render a meaningful search covering the entire claimed range impossible. Consequently, the search has been limited to the parts of the claims of which the subject matter appears to be clear, adequately supported and disclosed, i.e. the parts concerning the materials described in claims 5 to 19.